REMARKS

Amendments to Claims

Claims 9 and 10 have been amended as indicated, and new Claims 23-39 have been added. The amendments to Claims 9-10 are supported by the specification on page 5, line 21 to page 7, line 10. Support for new claims 23-28 can be found at and page 16, lines 7 to 13 as well as in the claims as originally filed. Support for Claim 39 can be found in Table 1 in which several examples of compositions containing two resin components are provided.

The Office rejected Claims 11, 13, 14 and 18-21 for informalities. Claims 11 and 18-21 have now been canceled. In Claim 13, "grou" has been amended to read "group" and "consising" amended to read "consisting". In Claim 14, "vesicle" has been amended to read "vehicle". Accordingly, the rejections relating to these informalities has been overcome.

Patentability of the Present Invention

The Office rejected claims 9-13 and 15-22 under 35 USC 102(b) and 35 USC 103(a) over Murakami (U.S. 4,212,786) (referred to hereinbelow as "D1") and Okuda (U.S. 4,829,108) (referred to hereinbelow as "D2"). Claim 14 was also rejected under 35 USC 103(a).

(I) Brief Summary of Invention

The rejected claims now recite **a mixture of at least two different solvents**. These solvents are then further defined. The presently claimed invention provides a solid composition having excellent wet-surface writing properties, high safety, satisfactory fluidity during manufacture, and no formaldehyde odor during manufacture and use. In particular, excellent wet-surface writing properties as well as high safety can be achieved by using the specific solvents recited in the claims. See Applicants' specification at Table 1 on page 18. In contrast, comparative examples using solvents outside the scope of the claims could not achieve both wet-surface writing properties and low toxicity. See Applicants' specification at Table 2 on page 20.

(II) D1 (Murakami; U.S. 4,212,786)

D1 describes a drawing crayon composition comprising

(a) at least one member selected from the group consisting of a cellulose resin or a vinyl resin,

(b) at least one member selected from the group consisting of an amide resin, ketone resin, xylene resin and terrene resin,

(c) at least one dibenzylidene sorbitol, tribenzylidene sorbitol and derivatives of the sorbitols,

(d) at least one of glycols, ethers of glycols, ether esters of glycols and benzoic acid esters, and

(e) an oil-soluble dye (column 2, lines 13-26, Claim 1).

In D1, as organic solvents, examples of glycols, ethers of glycols, ether esters of glycols and benzoic acid esters are simply described (lines 43 to 60 in column 4). Additionally, as pointed out by the Office, Murakami also generically contemplates solvents with a range of boiling points (100° to 250° C) capable of effectively dissolving the resins A and B, di- and tri-benzylidene sorbitols and derivatives thereof.

(III) D2 (Okuda et al; U.S. 4,829,108)

D2 discloses a solid coating composition comprising

(A) at least one of a vinyl resin and cellulose resin,

(B) at least one of a ketone resin and a xylene resin,

(C) an acrylic resin,

(D) at least one member selected from the group consisting of benzylidene sorbitol, dibenzylidene sorbitol, tribenzylidene sorbitol and a derivative thereof,

(E) at least one member selected from the group consisting of an ether of a glycol, ether ester of a glycol and a benzoic acid ester; and

(F) pigment (Claim 1).

In D2, as component (E), examples of ethers of glycols, ether esters of glycols and benzoic acid esters are simply described (lines 3 to 15 in column 5).

(IV) Analysis

(A) Novelty

As stated in MPEP 2131, "to anticipate a claim, the reference must teach every element of the claim." As described below, neither D1 nor D2 teaches every element of any of the claims.

As solvents in D1, ethylene glycol, diethylene glycol, propylene glycol, hexylene glycol; methyl ethers, ethyl ethers, propyl ethers, butyl ethers of the above-mentioned glycols; acetates, propionates of the above-mentioned glycol ethers; ethyl benzoate and butyl benzoate are specifically described.

As solvents in D2, methyl ethers, ethyl ethers, propyl ethers, butyl ethers of ethylene glycol, diethylene glycol, propylene glycol, hexylene glycol; fatty acid esters, acetates, propionates of the above glycol ethers; ethyl benzoate and butyl benzoate are specifically described.

Thus, neither D1 nor D2 teaches every element of the claim which is a solid composition comprising a colorant, a gelation agent, a resin component, and at least two particular solvents. This combination is not described either D1 or D2.

D1 and D2 also fail to describe the method for writing on a wet surface using a solid composition comprising solvents having the particular parameters recited in new Claims 23-38. Accordingly, these new claims are also novel over D1 or D2.

B. Nonobviousness

MPEP 2143 states: "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation for success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." In the case of the presently claimed invention, neither the first nor the third criteria are met.

Regarding the first criteria, D1 and D2 provide no motivation for the combinations of the specific solvents claimed, as they are silent with regard to desiring the property of writing on a wet surface or having low toxicity. No motivation is present in the references to conceive the solid composition of the present invention having excellent wet-surface writing properties and high safety by employing the specific solvents.

Regarding the third criteria, D1 and D2 do not teach or suggest the limitation of the particular mixtures of at least two solvents recited in the claims. Therefore, a *Prima Facie* Case of Obviousness has not been established.

In addition, D1 or D2 fails to teach or suggest that the solid composition comprising such elements can achieve excellent wet-surface writing properties, as well as low toxicity. Examples 1 through 6 from Table 1 of Applicants' specification are all examples according to the presently claimed invention. The results from Table 1 show that these composition with at least two of the recited solvent components has the desired properties of low toxicity and good wet-surface

writing. (See the bottom two rows of Table 1.) In contrast, none of Comparative Examples 1-8 from Table 2 provide both low toxicity and good wet-surface writing properties. The Comparative Examples are all outside the scope of the presently claimed invention. Comparative Examples 1-6 are identical to their corresponding Examples 1-6 other than the solvents used. Comparative Examples 7-8 are likewise identical to Examples 5-6 other than the solvents used. Accordingly, Tables 1 and 2 provide direct comparative data between solvents within the scope of the claims and those outside the scope of the claims. These results are completely unexpected in view of D1 and D2. As such, they provide strong evidence of the nonobviousness of the claimed invention.

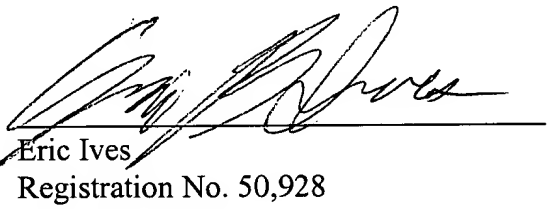
Furthermore, D2 teaches that at least three resin components, (A), (B) and (C), are essential (column 2, lines 58-68), especially the acrylic resin (C). This therefore teaches away from the invention recited in new Claim 39. It is improper to combine references where to do so would destroy the teaching of one. Accordingly, Claim 39 is patentable for this additional reason as well.

In view of the foregoing, the present invention is neither anticipated nor rendered obvious over D1 and D2. Applicant respectfully requests that all rejections be withdrawn and the claims be allowed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 7/6/2004

By: 

Eric Ives
Registration No. 50,928
Attorney of Record
Customer No. 20,995
(805) 547-5580

O:\DOCS\EBI\EBI-1522.DOC
070604